Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALBERTO CIARLA
and
FABIO LENCI

Appeal No. 2000-2128
Application No. 09/077,102

ON BRIEF

Before CALVERT, FRANKFORT, and NASE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 20, 21, 23 to 28 and 32. Claims 22, 29 and 30, the other claims remaining in the application, have been allowed.

The appealed claims are drawn to an automated rental system for battery powered scooters, and are reproduced in the appendix of appellant's brief.[1]

The references applied in the final rejection are:

Bae et al. (Bae)	4,983,903	Jan. 8, 1991
Guimarin et al. (Guimarin)	5,612,606	Mar. 18, 1997

The claims on appeal stand finally rejected on the following grounds:

(1) Claims 20 and 27, anticipated by Bae, under 35 U.S.C. § 102(b);

(2) Claims 20, 21, 23 to 28 and 32, unpatentable over Bae in view of Guimarin, under 35 U.S.C. § 103(a).

Rejection(1)

Claim 20, the only independent claim on appeal, reads (letters in brackets and emphasis added):

> 20. An automated rental system for battery powered scooters comprising in combination,

[1]The examiner notes that claim 23 should be dependent on claim 21. Also in reviewing the claims it appears that "receptacles" in claim 21, line 2, has no antecedent basis.

> [a] a scooter receptacle housing means for receiving at least one scooter thereinto into a working relationship <u>for servicing a rental transaction therein</u> and delivering rental scooters therefrom[,]

> [b] battery servicing means within the housing for processing batteries of scooters returned from a rental transaction to ready the scooters for a further rental transaction, and
>
> [c] computerized control means operable for automated monitoring, commanding and controlling both vehicle renting and battery servicing operations for scooter rentals and returns.

"To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). "Furthermore, with an element expressed in terms of a means plus function, 'absent structure [in a prior art reference] which is capable of performing the functional limitation of the 'means,' [the prior art reference] does not meet the claim.' In re Mott, 557 F.2d 266, 269, 194 USPQ 305, 307 (CCPA 1977)." RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In the present case, Bae discloses a system for removing, servicing (recharging) and replacing the batteries of battery-powered automatic guided vehicles (AGVs). However, Bae does not disclose that the AGVs are rented, nor any apparatus for servicing rental transactions.

Claim 20 would therefore seem to distinguish over Bae, in that it recites a "housing means . . . for servicing a rental transaction therein" in part [a], and "computerized control means operable for automated monitoring, commanding and controlling
. . . vehicle renting . . . for scooter rentals and returns" in part [c]. However, the examiner takes the position that this language is "merely intended uses which are given very little patentable weight," and that Bae "is able to meet this functional language as it could receive and service a battery powered scooter" (final rejection, page 3). He also asserts at page 4 of the answer that "[t]he battery exchange as performed by Bae et al. may be part of a 'rental transaction.'"

We do not consider the examiner's position to be well taken. The language which the examiner characterizes as "merely intended uses" constitutes recitations of the functions of two means-plus-function elements of claim 20 (the "housing means" and the "computerized control means"); it therefore cannot be minimized or ignored, but rather, in order to anticipate the claim, Bae must disclose structure capable

of performing those functions. RCA Corp., supra. Contrary to the examiner's assertion, supra, we do not consider that "servicing a rental transaction," even if given its broadest reasonable interpretation (In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993)), can be considered to read on Bae's disclosed system for exchanging a battery, nor would Bae's computer control of the battery exchange system constitute the computerized control means called for in claim 20, part [c], which, it should be noted, is recited as being for "both vehicle renting and battery servicing operations" (emphasis added).

Accordingly, rejection (1) will not be sustained.

Rejection (2)

The examiner applies Guimarin as follows (final rejection, page 5):

> It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bae et al. with the teachings of Guimarin in order to have precise and efficient computerized control of the battery servicing operation and to protect the batteries during transport. It would have been obvious to one of ordinary skill in the art to use this combination to service any electric vehicle such as battery powered scooters.

However, whatever may be the merits of this conclusion of

obviousness, Guimarin does not disclose a vehicle rental system, and therefore does not overcome the deficiencies of Bae noted in the foregoing discussion of rejection (1).

At page 4 of the final rejection, the examiner seems to be of the view that on page 7 of the amendment filed on July 16, 1999 (Paper No. 5), appellants admitted that a computerized control means as recited in part [c] of claim 20 was prior art. We have reviewed the part of the amendment in question, but do not find therein any admission by appellants that a computerized control for automated monitoring, commanding and controlling of vehicle renting was known in the prior art.

Rejection (2) therefore will not be sustained.

Conclusion

The examiner's decision to reject claims 20, 21, 23 to 28 and 32 is reversed.

REVERSED

IAN A. CALVERT)
Administrative Patent Judge)
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